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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

037925.0002

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on 7/24/2008Signature Rachelle GruenbergTyped or printed name Rachelle Gruenberg

Application Number

10/629,304

Filed

7/30/2003

First Named Inventor

Morrie, Daniel R.

Art Unit

3629

Examiner

Matthew Meyers

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

 applicant/inventor. assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/98) attorney or agent of record.Registration number 38,076 attorney or agent acting under 37 CFR 1.34.Registration number if acting under 37 CFR 1.34 Signature Thomas F. Bergert

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7/24/2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below.

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**PRE-APPEAL BRIEF REMARKS**

Applicant submits that the final Office Action issued on January 25, 2008 by the Examiner in the present application contains clear errors in the Examiner's rejections as well as omissions of one or more essential elements needed for a *prima facie* rejection.

The Examiner has rejected claims 1-30 under 35 USC 103(a) as being unpatentable over two non-patent references to the Mortgage Electronic Registration System (MERS and MERS II) and U.S. Patent Application Publication No. 2002/0107703 to Feinberg et al. (hereinafter "Feinberg"). "MERS" refers to the article, "For Mortgages—MERS emerges," Bankers Research February 1997. "MERS II" refers to the article, "MERS aids electronic mortgage market," Mortgage Banking, January 1997.

Specifically, the Examiner has cited page 1 of MERS for the claim 1 element, "calculating at least one trigger date associated with a property-related lien, the trigger date indicative of when the property-related lien is required to be released by a lien holder associated with the property-related lien." The Examiner cited the following passage of MERS on pages 3-4 of the Office Action:

One additional benefit will be important to present owners and new borrowers. There are today many properties on which the mortgages have been paid off but in which no one will file to release the lien. A common case is when the mortgage was made by a savings & loan that was taken over by the Resolution Trust Company. The original lender no longer exists, and the RTC often won't file the paper, contending it has no authority to do so. With MERS mortgages, MERS will be able to file the release.

Further on page 4 of the Office Action, the Examiner has cited page 5 of MERS II for the claim 1 element, "determining that the property-related lien is required to be released and has not been released by the trigger date." The Examiner's citation to MERS II is as follows:

He notes that all parties will more easily be able to track loans to ensure that contractual obligations are met.

This rejection of claim 1 is deficient on its face in that all the Examiner has done is repeat verbatim the claimed elements/steps and refer to two sections of the prior art references

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without providing an explanation of how the prior art reads on the claims. There has been no attempt on the Examiner's part to equate or particularly point out specific language in the prior art and apply it to the claimed elements/steps.

With regard to the citation of MERS against the first cited element of claim 1 above, there is absolutely nothing whatsoever in this cited portion of MERS that even remotely reads on the step/element of calculating a trigger date associated with a property-related lien, the trigger date indicative of when the property-related lien is required to be released by a lien holder associated with the property-related lien. With regard to the citation of MERS II against the second cited element of claim 1 above, the MERS II citation refers to *contractual* obligations and not *statutory* obligations. Real property loan agreements will not include an obligation on the part of the lender to release a lien within a period of time after the underlying note is paid – this is a *statutory* requirement. Hence, the MERS II citation only confirms MERS' role and lack of relevance to the invention as presently claimed.

Applicant's invention is disclosed in the specification of the present application, and Applicant has provided comments regarding Applicant's invention in the past. See, for example, pages 8-9 of Applicant's response dated October 31, 2007. Applicant has also provided information as to the Mortgage Electronic Registration System (MERS) in Applicant's information disclosure statement dated June 3, 2008 (see, e.g., Section IV on pages 12-15 of Missouri Law Review article cited therein). Such information supports Applicant's position that the application of MERS is clearly erroneous in the present application.

In addition to the above, Applicant takes note that, in its co-pending application serial no. 10/630,532, the Examiner had previously applied MERS as prior art against a claim element ("identifying at least one lien where a note underlying the at least one lien has been satisfied, and identifying whether the at least one lien...is due for release") which is similar to claim elements in the present application. However, in a subsequent Office Action in the '532 application issued on July 17, 2008, the Examiner removed the application of MERS from

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this claim element. Thus, the Examiner now appears to agree that MERS is not applicable to such claim language.

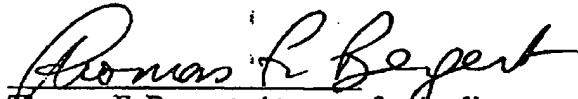
The above discussion highlights MERS' most significant omissions with respect to the present invention. The complete lack of disclosure with respect to anything other than recording lien ownership effectively negates MERS's usefulness as a reference against the present invention. The Examiner's actions in co-pending application no. 10/630,532 acknowledge this.

Thus, it has been shown that contrary to the requirements of 35 USC 103(a), MERS does not teach or disclose many of the recited clauses contained in claim 1 of the present invention. The other independent claims contain similar or exact recitations for the steps and/or elements as those in claim 1. The chief difference is that the other independent claims are characterized from a different perspective such as a system or article of manufacture. The analysis pertaining to claim 1, however, applies equally to the other independent claims. In addition, the dependent claims would be allowable if the base independent claim were allowed.

It is Applicant's belief that the Examiner has mischaracterized and misapplied the teachings of MERS as it pertains to the claims of the present invention for the reasons set forth above. Reconsideration and withdrawal of rejected claims 1-30 based on MERS is requested.

Respectfully submitted,

Date: 7/24/2008

  
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